



09-12.05

BFW

PTO/SB/21 (07-06)

Approved for use through 09/30/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

| | | | |
|---|-----------------------------|-------------------------------|-------------|
| Application Number | 10/659,164 | | |
| | Filing Date | September 10, 2003 | |
| | First Named Inventor | Eric Bacque et al. | |
| | Art Unit | 1626 | |
| | Examiner Name | Janet L. Coppins | |
| Total Number of Pages in This Submission | | Attorney Docket Number | 8674-000025 |

ENCLOSURES (check all that apply)

| | | |
|---|--|---|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard |
| Remarks The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed. | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

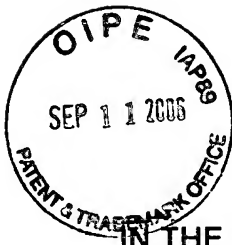
| | | | |
|--------------------------------|----------------------------------|---|-------------------------------------|
| Firm or Individual name | Harness, Dickey & Pierce, P.L.C. | Attorney Name Monte L. Falcoff Jennifer Woodside Wojtala | Reg. No. 37,617 50,721 |
| Signature | | | |
| Date | September 11, 2006 | | |

CERTIFICATE OF TRANSMISSION/MAILING

| | | | |
|---|--|------------------------------|-------------------------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. | | | |
| Typed or printed name | Monte L. Falcoff / Jennifer Woodside Wojtala | Express Mail Label No | EV 757 777 887 US (9/11/2006) |
| Signature | | Date | September 11, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

EV 757 777 887 US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/659,164
Filing Date: September 10, 2003
Applicant: Eric Bacque et al.
Group Art Unit: 1626
Examiner: Janet L. Coppins
Title: QUINOLYLPROPYLPIPERIDINE DERIVATIVES,
INTERMEDIATES AND COMPOSITIONS CONTAINING
THEM, AND PREPARATION THEREFOR
Attorney Docket: 8674-000025

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Sir:

In response to the Office Action mailed August 9, 2006, please consider the following. In the above identified Office Action, the Examiner determined that currently pending Claims 1-24, are subject to a restriction requirement pursuant to 35 U.S.C. §121. The Examiner has required restriction to one of the following inventions –

- I. Claims 1-6 and 11, drawn to compounds of formula (I) and their compositions, classified in various subclasses of class 546;

- II. Claims 7-10, drawn to a process of preparing compounds according to formula (I), classified in class 546, various subclasses;
- III. Claims 12-14, drawn to compounds of different formula (II), classified in class 546, subclasses 152+;
- IV. Claims 15-17, drawn to compounds of formulae (A-C), classified in various subclasses of class 546;
- V. Claim 18, drawn to an intermediate compound of formula (VII), classified in class 546, subclasses 184+;
- VI. Claim 19, drawn to a different intermediate compound of formula (VIII), classified in class 546, subclass 152;
- VII. Claims 20-24, drawn to methods of using compounds according to formula (I), classified in various subclasses of class 514.

In addition, the Examiner has required an election of a single disclosed compound (in the specification), including an exact definition of each substituent on the base molecule (formulae I, II, A, B, or C), wherein a single member at each substituent group or moiety is selected.

Response to Restriction Requirement

Applicants traverse the restriction requirement, as the examination of the above identified claims does not appear to impose a serious burden upon the Examiner. However, to facilitate prosecution, Applicants hereby elect to prosecute the claims of Group I corresponding to Claims 1-6 and 11.

The right is hereby reserved to file further continuation and/or divisional patent applications directed to the restricted subject matter and Applicants are not, in any manner, waiving or abandoning any rights to this subject matter.

The Office Action indicates that upon allowance of claims corresponding to Group I that commensurate claims corresponding to the withdrawn invention identified as Group VII may be rejoined in the application. Thus, Applicants reserve the right for rejoinder of Claims 20-24.

Response to Election Requirement

In response to the election requirement, Applicants further elect the species for Formula I of Claim 1: 1-(2-Cyclohexylsulfanylethyl)-4-[3-(3-fluoro-6-methoxyquinolin-4-yl)-3-oxopropyl]piperidine-3-carboxylic acid, as identified in Claim 6 lines 24-26 and further at Page 5 lines 1-3 and Page 35 lines 25-27 of the specification, for example. With regard to Formula I of Claim 1, the elected species corresponds to the selection of the following moieties: R₁ = fluorine; R₂ = carboxyl group; R₃ is a C₂ substituted with a C₆ cycloalkylthio, namely 2-cyclohexylsulfanylethyl, and R₄ is a C₁ alkyl or a methyl group. In this regard, Applicants submit that independent Claim 1, as well as dependent Claims 2-6 and 11 read upon the elected species.

CONCLUSION

It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this Response is respectfully requested. If the

Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: September 11, 2006

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

MLF/JMW

By: Jennifer M. Woodside Wojtala

Monte L. Falcoff
Reg. No. 37,617

Jennifer M. Woodside Wojtala
Reg. No. 50,721